

REMARKS

This is a full and timely response to the non-final Official Action mailed July 30, 2003 (Paper No. 13). Reconsideration of the application in light of the foregoing amendments and the following remarks is respectfully requested.

By the present amendment, claim 2 is cancelled. Claims 16 and 17 were cancelled previously. Various claims are amended and new claims 27-34 are added. Thus, claims 1, 3-15 and 18-34 are currently pending for the further consideration.

Claims 8 and 9 have been allowed. Applicant appreciates the allowance of these claims. New claims 27-33 depend from claim 8. Therefore, newly-added claims 27-33 should be clearly allowable based on the previous allowance of claim 8.

With regard to the prior art, the Office Action rejected claims 1, 2, 4-7, 10-15, 18-21 and 23-25 as anticipated under 35 U.S.C. § 102(b) by EP 0519667 A1 to Kikuchi ("Kikuchi"). Claims 3, 22 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Kikuchi and U.S. Pat. No. 5,220,602 to Robbins et al. ("Robbins"). These rejections are respectfully traversed.

Claim 1 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein the first signal path comprises a NICAM surface acoustic wave filter, coupled to receive the tuned signal from the tuner and configured and arranged to pass a NICAM signal component of the tuned signal and to substantially reject non-NICAM signal components of the tuned signal.

(emphasis added)

In contrast, Kikuchi fails to teach or suggest the claimed NICAM surface acoustic wave (SAW) filter coupled to the tuner. The use of a NICAM SAW filter is also recited in independent claims 11, 18 and 23.

A SAW filter is a filter characterized by its reliance on acoustic energy and electrical/acoustic transducers used to take advantage of impressive bandpass filter shape factors that are difficult to achieve with more traditional filter technologies. Kikuchi does not mention, teach or suggest a SAW filter or a filter that operates on these principles.

According to the Office Action, Kikuchi's "filter 18 is eventually a NICAM SAW filter because only [a] NICAM signal component of the tuned signal is filtered out [by filter 18]." (Paper No. 13, p. 4). However, the mere fact that Kikuchi's NICAM filter (18) filters out a NICAM signal component does not suggest that the filter (18) is a SAW filter using acoustic energy and electrical/acoustic transducers. ***There is no reason to conclude that the filter (18) taught by Kikuchi is a SAW filter as claimed.*** Consequently, the rejection of claims 1, 11, 18 and 23 based on Kikuchi is insufficient. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); *see also*, MPEP § 2112 (quoting Levy).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *See M.P.E.P. § 2131*. Consequently, because Kikuchi fails to teach or suggest the claimed SAW filter, the rejection of claims 1, 11, 18 and 23, and their respective dependent claims, should be reconsidered and withdrawn.

Claim 4 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein said first signal path comprises an alignment-free filter coupled to receive the tuned signal from the tuner and configured and arranged to pass a NICAM

signal component of the tuned signal and to substantially reject non-NICAM signal components of the tuned signal.
(emphasis added).

Claim 11 also recites the use of an alignment-free filter.

In contrast, Kikuchi fails to teach or suggest “an alignment-free filter coupled to receive the tuned signal from the tuner.” Rather the Office Action asserts *without any support* that the filter (18) taught by Kikuchi is an “alignment-free filter.” (Paper 13, p. 4)

According to Applicant’s specification, an alignment-free filter is “a filter which is manufactured to pass a certain band and which is not, and cannot, thereafter be adjusted.” (Spec., p. 7). However, there is no teaching or suggestion in Kikuchi that filter (18) meets this definition.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Kikuchi fails to teach or suggest the claimed alignment-free filter, the rejection of claims 4 and 11 based on Kikuchi should be reconsidered and withdrawn.

Claim 10 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein the first signal path is constructed as a unitary circuit module.
(emphasis added).

According to Applicant’s specification, in “a particular embodiment of the present invention, the NICAM SAW filter 226, mixer 228, and low pass filter 230 may be constructed as a unitary circuit module. This circuit module can be removed from the converter terminal and replaced easily and at relatively little cost.” (Spec., p. 15). In contrast,

Kikuchi fails to teach or suggest that the first signal path is constructed as a unitary circuit module.

According to the Office Action, the fact that a dashed-line box is used to group the elements of a digital audio signal path in Fig. 3 means that the digital audio path is formed as a unitary circuit block. (Paper No. 13, p. 5). However, this is insufficient as a matter of law.

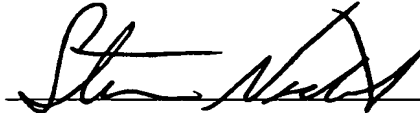
The box (32) in Fig. 3 of Kikuchi is used merely for the purpose of discussing the elements of the digital audio path as a group and does not indicate structure. There is no teaching or suggestion in Kikuchi that the elements of the digital audio path are physically formed as a unitary circuit module.

Under the circumstances, the Office must show that Kikuchi teaches that the elements of the digital audio path must be or necessarily are formed as unitary module. See MPEP § 2112 (quoting *Ex parte Levy*). This, the Office Action has not done.

Thus, Kikuchi clearly fails to teach or suggest that the elements of the first signal path are constructed as a unitary circuit module as claimed. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, the rejection of claim 10 based on Kikuchi should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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